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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/781,329 | 02/13/2001 | Koji Fukumoto | 826.1675/JDH | 9064 |
| 21171 | 7590 | 08/11/2006 | EXAMINER | |
| STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | NASH, LASHANYA RENEE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2153 | |

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/781,329 | FUKUMOTO ET AL. |
| | Examiner LaShanya R. Nash | Art Unit 2153 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 May 2006.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,2 and 4-9 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1,2 and 4-9 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

This action is in response to an Amendment filed May 10, 2006. Claims 1,2, and 4-9 are presented for further consideration. Claims 1 and 4 are currently amended. Claim 3 is canceled.

Response to Arguments

Applicant's arguments, see Remarks/Claim Rejections –35 U.S.C. § 102, with respect to claims 1,2, and 4-9 have been fully considered, but are moot in view of the new grounds of rejection under 35 U.S.C. § 103 as set forth below in the Office action.

In considering the Applicant's arguments the following factual remarks are noted:

- (I) Applicant contends that Gilbert does not teach, disclose, or suggest, storing keyword information predetermined for respective receivers, wherein the keyword information is designated by the sender and different for respective receivers and that Gilbert teaches away from the modification proposed to teach these limitations.
- (II) Applicant contends that Krause does not show keywords that are predetermined for respective receivers or designated by the sender and different for respective receivers.
- (III) Applicant contends that Gilbert does not show transmitting the E-mail information including all of the transmission information to the respective receivers.

In considering (I), Applicant contends that Gilbert does not teach, disclose, or suggests, storing keyword information predetermined for respective receivers, wherein the keyword information is designated by the sender and different for respective receivers and that Gilbert teaches away from the modification proposed to teach these limitations. Examiner respectfully disagrees. In response to applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Gilbert expressly discloses creating individualized messages, wherein each user receives the entire message, wherein portions are emphasized for the respective receiver (Figure 6). However, Gilbert does not teach away from storing keyword information predetermined for respective receivers, wherein the keyword information is designated by the sender and different for respective receivers as suggested by the Applicant. The features disclosed by Gilbert expressly teach a user generating multiple versions of the originating message based on who is the receiver (i.e. original Figure 6-item 162 & multiple versions based on the user Figure 6-items 164, 166, and 168), however without the labor intensive process of a user manually generating (i.e. retyping) each individual version of the entire message (column 1, lines 23-26). The Examiner further asserts that Gilbert explicitly discloses a user applying

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various designating indications (i.e. identifier codes; column 6, lines 10-31; column 7, lines 8-24) that represent the respective receivers in which different parts of an E-mail are to be emphasized for, (e.g. John is identified with "a" and Fred identified with "b"; column 8, lines 1- 43; Figure 5). Therefore, there is a suggestion of further using predetermined keywords, as disclosed by Krause, as an indication for an originating user to select a corresponding change in the message for a particular user. Given this feature of keyword selection, as disclosed by Krause, a person of ordinary skill in the art at the time of the invention would have readily recognized the advantages of modifying the recipient-specific E-mail system disclosed by Gilbert in order for the recipient to maximize their speed and comprehension in reading electronic mail content (Krause column 3, lines 24-26). As a result, Examiner maintains the rejections as set forth below in the Office action.

In considering (II), Applicant contends that Krause does not show keywords that are predetermined for respective receivers or designated by the sender and different for respective receivers. As previously discussed in considering (I), Examiner asserts that Gilbert discloses indications that are predetermined for respective receiving users that can be designated by the sender and different for each receiving user in order to subsequently identify which changes (i.e. emphasis) are to be made to the message based on the aforementioned user, (column 8, lines 1- 43; Figure 5). Examiner additionally asserts, that Krause is cited in order to teach the limitations of predetermined keyword information predetermined for a respective user to be

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highlighted in transmission information, (column 7, lines 19-38; Figure 14). As a result, the Examiner asserts that Gilbert in combination with Krause, as set forth below in the Office action, teach keywords that are predetermined for respective receivers or designated by the sender and different for respective receivers as recited in the claims.

In considering (III), Applicant contends that Gilbert does not show transmitting the E-mail information including all of the transmission information to the respective receivers. Examiner respectfully disagrees. Gilbert expressly discloses that the respective systems of each recipient user receive the original message as encoded by the sending user (Figure 5; Figure 4B-item 90), which is inclusive of information that is encoded for the other receiving recipients (i.e. all of the transmission information). In addition, the encoded received message is subsequently decoded for the respective receiver and the receiving system generates the properly formatted email message with the individualized modifications, (column 7, lines 25-65; Figure 4B). Examiner additionally asserts that all of the transmission information (i.e. original message containing information for DICK, MARY, and HARRY; Figure 6-item 162) is received by and contained in the individualized messages for each of the recipients, thereby allowing the originating user to automatically generate multiple versions of the original message for other recipients based on who is the receiver (Figure 6-items 164, 166, and 168) which is disclosed by Applicant as a feature of instant invention (Remarks; page 6). As a result, Examiner maintains the rejections as set forth below in the Office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2 and 4-9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (US Patent 6,529,942) and further in view of Krause et al. (US Patent 6,154,757).

Gilbert teaches an email system and method which allows the originating user to customize text for a specific recipient in a multiple recipient email system (i.e. broadcast), (abstract).

In reference to claim 1, Gilbert shows that the E-mail system with recipient-specific content system includes:

- A receiving device (i.e. receiver; Figure 1-receiver) receiving transmission information transmitted from a sender (Figure 1-sender) to a plurality of receivers, (column 3, line 24 to column 4, line 30) and
 - An emphasizing device (i.e. network computer of sender) emphasizing and highlighting (i.e. size, color, bold, italic, etc.; column 4, lines 54-67);
 - A storing device (i.e. memory; column 3, lines 34-41) storing information predetermined for respective receivers (i.e. identifier codes; column 6,

lines 10-31; column 7, lines 8-24), wherein the information is designated by the sender and different for respective receivers (e.g. John is identified with "a" and Fred identified with "b"; column 8, lines 1- 43; Figure 5);

- Different parts the transmission information for respective receivers (i.e. select users to receive modified email message; column 5, lines 5-26), and preparing E-mail information (i.e. embedding text format commands and identifier codes; column 8, lines 1-18) including all of the transmission information with the transmission information in which the different parts are for respective receiver (columns 5-7; Figure 5),
- A transmitting device transmitting the E-mail information including all of the transmission information to respective receivers (i.e. receiver sensitive formatting; Figure 6- Emails for John, Harry, Mary and Original Email), (column 8, line 44 to column 9, line 18).

Gilbert shows substantial features of the claimed invention. However, Gilbert does not teach a storing device storing keyword information predetermined for each receiver and subsequently highlighting these keywords included in E-mails. Nonetheless this feature would have been an obvious modification to the system disclosed by Gilbert as evidenced by Krause.

In an analogous art, Krause discloses an electronic text reading environment enhancement method and apparatus in which designated words and phrases can be emphasized in an electronic text (column 3, lines 59-63). Specifically, Krause shows a wordlist comprised of various words and phrases for the user (column 7, lines 19-38

and Figure 3). The contents of the wordlist are highlighted within displayed electronic text (column 29, lines 48-52 and Figure 14).

Given this feature a person of ordinary skill in the art at the time of the invention would have readily recognized the advantages of modifying the recipient-specific E-mail system disclosed by Gilbert in order for the recipient to maximize their speed and comprehension in reading electronic mail content (Krause column 3, lines 24-26).

In reference to claim 2, Gilbert shows receiving device that receives a part of the transmission information that the sender designates and information about a corresponding transmission destination and emphasizing device that emphasizes and highlights the designated part and prepares E-mail information for a receiver corresponding to the transmission destination, (columns 5-6).

In reference to claim 4, Gilbert shows a terminal apparatus (Figure 1-sender) comprising:

- Transmitting device transmitting transmission information prepared for a plurality of receivers (i.e. via network connection; column 3, lines 58 to column 4, line 16) including all of the transmission information and information predetermined for respective receivers (i.e. identifier codes; column 6, lines 10-31; column 7, lines 8-24), wherein the information is designated by the sender and different for respective receivers (e.g. John

is identified with "a" and Fred identified with "b"; column 8, lines 1- 43; Figure 5); and

- An indication device (i.e. software program executing on networked computer of sender; column 4, line 30 to column 5, line 5) indicating E-mail information that emphasizes and highlights different parts of the transmission information for respective receivers; preparing E-mail information for respective receivers including all of the transmission information (columns 6-7); and
- Transmitting the E-mail information for respective receivers, with all of the transmission information sent to all respective receivers (i.e. receiver sensitive formatting; Figure 6- Emails for John, Harry, Mary and Original Email), (column 5; columns 8-9).

Gilbert shows substantial features of the claimed invention. However, Gilbert does not teach a storing device storing keyword information predetermined for each receiver and subsequently highlighting these keywords included in E-mails. Nonetheless this feature would have been an obvious modification to the system disclosed by Gilbert as evidenced by Krause.

In an analogous art, Krause discloses an electronic text reading environment enhancement method and apparatus in which designated words and phrases can be emphasized in an electronic text (column 3, lines 59-63). Specifically, Krause shows a wordlist comprised of various words and phrases for the user (column 7, lines 19-38

and Figure 3). The contents of the wordlist are highlighted within displayed electronic text (column 29, lines 48-52 and Figure 14).

Given this feature a person of ordinary skill in the art at the time of the invention would have readily recognized the advantages of modifying the recipient-specific E-mail system disclosed by Gilbert in order for the recipient to maximize their speed and comprehension in reading electronic mail content (Krause column 3, lines 24-26).

In reference to claim 5, Gilbert discloses developed software program including instructions to carry out the recipient specific email methods on computing systems (column 4, lines 16-67). As applied to previous claims, functions of the electronic mail system, as shown by Gilbert, include: receiving transmission information from a sender to a plurality of receivers; emphasizing and highlighting the different parts of transmission information for each receiver; preparing E-mail information for respective receivers; and transmitting the E-mail information for respective receivers. Therefore, Gilbert teaches a system comprising executable code that specifically implements the previously stated functions. This is equivalent to the software program disclosed by the applicant.

In reference to claim 6, Gilbert shows a method (Figures 2&4; columns 4-7) comprising:

- Preparing transmission information to be transmitted from a sender to a plurality of receivers (Figure 2-item 60); and

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- Emphasizing and highlighting the transmission information for respective receivers (Figure 2-items 64-68);
- Preparing E-mail information for respective receivers, (Figure 2-item 72);
- Transmitting the E-mail information including all of the transmission information to all respective receivers, (Figure 2-item 73);
- Emphasizing and displaying the transmission information for respective receivers, (Figure 2-item 76; Figure 4a; Figure 6; column 8).

In reference to claim 7, Gilbert explicitly discloses an E-mail system (Figure 1), comprising:

- Receiving means (Figure 1-receiver) for receiving transmission information transmitted from a sender (Figure 1-sender) to a plurality of receivers, transmitting means for transmitting the E-mail information for each receiver (column 3, line 24 to column 4, line 30); and
 - Emphasizing means (i.e. network computer of sender) for emphasizing and highlighting (i.e. size, color, bold, italic, etc.; column 4, lines 54-67) the transmission information for respective receivers (i.e. select users to receive modified email message; column 5, lines 5-26), and preparing the email (i.e. embedding text format commands) for respective receiver (columns 5-7),
 - Transmitting the E-mail information including all of the transmission information to all respective receivers (i.e. receiver sensitive formatting;

Figure 6- Emails for John, Harry, Mary and Original Email), (column 5; columns 8-9).

In reference to claim 8, Gilbert discloses the E-mail system with recipient-specific content system includes:

- A system (Figure 1) for propagating a signal from a propagating computer (i.e. Figure 1-sender) to receiver computers (i.e. Figure 1-receiver), (i.e. via network; Figure 1-item 10) the propagating computer of the system comprising a program (i.e. software program; column 4, lines 30-67),

As applied to previous claims, functions of the electronic mail system, as shown by Gilbert, include: receiving transmission information from a sender to a plurality of receivers; emphasizing and highlighting the different parts of transmission information for each receiver; preparing E-mail information for respective receivers; and transmitting the E-mail information including all of the transmission information to respective receivers.

In reference to claim 9, Gilbert explicitly discloses a method (Figures 2&4; columns 4-7) for recipient-specific content emailing. Gilbert discloses the method to comprise:

- Receiving information for different destinations with the information having different parts (Figure 2-items 60-64);

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- Emphasizing the different parts responsive to the destinations (Figure 2-item 68-72; Figure 3);
- Sending all of the information by email to all the destinations with each destination receiving all of the information, to with at least one of the parts emphasized responsive to the destination (Figure 2-item 73); and
- Displaying the information with one of the parts emphasized at least one of the destinations, (Figure 2-item 76; Figure 4a; Figure 6; column 8).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShanya R Nash whose telephone number is (571) 272-3957. The examiner can normally be reached on M-F 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LaShanya Nash
Art Unit, 2153
August 1, 2006



GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100